

### REMARKS

Applicants respectfully request consideration of the subject application as amended herein. Claims 1-54 are currently pending in this application. Claims 1, 6, 7, 17, 18, 21, 26-28, 33, 34, 39, 45-47, and 54 have been amended.

#### Claim Rejections - 35 U.S.C. § 112

Claims 17-21, and 27 were rejected under 35 U.S.C. 112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims have been amended to overcome this rejection, and applicant respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 112, second paragraph.

#### Claim Rejections - 35 U.S.C. § 102

Claims 1-6, 8-22, 26 and 27 were rejected under 35 U.S.C. 102 (b) as being anticipated by Giba et al. (U.S. 5,876,373). Applicant respectfully disagrees in light of amendments filed herein.

Giba teaches a steerable catheter for placement within a heart chamber. Referring to figure 1 and Col. 8, lines 7-18, the catheter includes a proximal end 104, an elongated central torquing portion 110, and a deflectable end portion 106. The catheter also includes a center tube 114 and a coil spring 130 which is located in the distal end portion 106. Giba teaches that the end portion may be more flexible than a central torquing portion (Col. 8, lines 14-18).

Giba does not teach that deflectable end portion 106 has varying degrees of flexibility determined by constraining the coil. Giba does not teach varying flexibility by constraining the

coil. For this reason alone, applicant believes that this rejection no longer applies. Additionally Giba does not teach that the distal portion is adapted to couple to a contraceptive device. Giba does not teach that the distal portion is adapted to couple to any device, which is logical as Giba teaches that the distal portion is configured to deliver laser energy and not implants.

In light of the foregoing arguments applicant believes that claims 1-6, 8-22, 26 and 27 are not anticipated by Giba and respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 102(b).

Claims 28-35 and 37-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Khera et al., U.S. 6,763,833B1. Applicant respectfully disagrees.

Khera does not teach applicants amended claim limitations as outlined in the above argument. Applicant also notes that the Office Action made several arguments with respect to the catheter which referred to figure 3; figure 3 regards a contraceptive device, and is not a catheter. Applicant believes that claims 28-35 and 37-44 are not anticipated by Khera and respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 102(b).

Claims rejections - 35 U.S.C. 103

Applicant respectfully notes that the claims in U.S. 6,763,833, application No. 09/644,277 (Khera), and the current application are and were both subject to an obligation of assignment to the same entity, Conceptus, Inc., at the conception of both applications. Applicant submits that the inventors of the current application, and assignee Conceptus, Inc., were in an employment agreement before the invention(s) were made, and that the claims of the current application were the result and within the scope of that employment agreement, and that all the parties of the agreement (the listed inventors and assignee Conceptus, Inc.) are currently disclosed in the current

disclosed in the current application. Therefore applicant believes that any rejection under 35 U.S.C. 103(b) over Khera would be precluded by 35 U.S.C 103(c).

Claims 7, 23-25, and 45-54 were rejected under 35 U.S. C. 103(a) as being unpatentable over Giba et al., U.S. 5,876,373. Applicant respectfully disagrees.

As shown above, Giba fails to satisfy all the claim elements of the base claims for dependent claims 7 and 23-25, upon which this rejection is based upon, and which this rejection does not address. Similarly, claim 45 has been amended in the manner of claim 1, and therefore applicant believes this rejection no longer applies to claims 45-54.

In light of the foregoing arguments applicant believes that claims 7, 23-25, and 45-54 are patentable over Giba, and respectfully requests the Examiner to withdraw the rejection under 35 U.S.C. 103(a) be withdrawn.

Claim 36 was rejected under 35 U.S. C. 103(a) as being unpatentable over Khera et al., U.S. 6,763,833 B1. As noted above, applicant believes this rejection is precluded by 35 U.S. C. 103(c) and respectfully requests the Examiner to withdraw the rejection.

#### Claim Objections

Claims 6, 7, 17, 18, 21, 27, 39, 46, and 47 were rejected to for various informalities. The claims have been amended to overcome the objections, and applicant respectfully requests the Examiner to withdraw the objections.

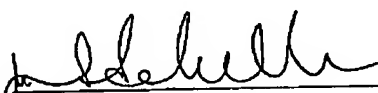
Applicant respectfully submits that in view of the amendments and arguments set forth herein, the applicable rejections have been overcome.

Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

Respectfully submitted,

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